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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,937	08/18/2003	Binh T. Nguyen	3718611-06135	4289

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EXAMINER	
YOO, JASSON H	

ART UNIT	PAPER NUMBER
3718	

NOTIFICATION DATE	DELIVERY MODE
01/21/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary	Application No.	Applicant(s)	
	10/642,937	NGUYEN ET AL.	
	Examiner	Art Unit	
	Jasson H. Yoo	3718	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 November 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6,7,9-15,17-21,24,25,27-29,61,62 and 64-68* is/are pending in the application.

4a) Of the above claim(s) *10-12,27-29,65 and 66* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3, 6, 7, 9, 13-15, 17-21, 24, 25, 61-62, 64, 67, 68* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Based upon consideration of all the relevant factors with respect to the claim as a whole, Claim(s) 1-3, 6-7, 9-15, 17-20 are held to claim an abstract idea, and [is/are] rejected as ineligible subject matter under 35 U.S.C. 101.

The rationale for this finding is explained below, which is a result of careful consideration of the listed factors when analyzing the claim(s) as a whole to evaluate whether a method claim is directed to an abstract idea. These factors are not intended to be exclusive or exhaustive.

I. Factors weighing toward eligibility are:

a) Recitation of a machine or transformation: In particular, machine or transformation meaningfully limits the execution of the steps, a machine implements the claimed steps, the article being transformed is particular, an object or substance, the article undergoes a change in state or thing (objectively different function or use);

b) Practically applying a law of nature to meaningfully limit the execution of the steps; or

c) The claim is more than a mere statement of a concept: It describes a particular solution of the problem to be solved; implements a concept in a tangible way, performance of steps are observable and verifiable.

II. Factors weighing against eligibility are:

a) No recitation or insufficient recitation of a machine or transformation:

+ Insufficient involvement of the machine or transformation, merely nominally, insignificantly, or intangibly related to the performance of the steps, (e.g., data gathering, or merely recites a field in which the method is intended to be applied).

+ Machine is generically recited such that it covers any machine capable of performing the claimed step(s) or merely an object on which the method operates.

+ Transformation involves only a change in position or location of the article.

b) Improperly applying a law of nature that would monopolize a natural force or patent a scientific fact (e.g., by claiming every mode of producing an effect of that law of nature); or applied in a merely subjective determination or merely nominally, insignificantly, or tangentially related to the performance of the steps; or

c) The claim is a mere statement of a general concept: Use of the concept, as expressed in the method, would effectively grant a monopoly over the concept; or both known and unknown uses of the concept are covered, and can be performed through any existing or future-devised machinery, or even without any apparatus; or states only a problem to be solved; or general concept is disembodied; or mechanism by which the step(s) are implemented is subjective or imperceptible.

+ Examples of general concepts: Basic economic practices or theories, basic legal theories, mathematical concepts, mental activity, interpersonal relations or relationships, teaching concepts, human behavior, and instructing how business should be conducted.

Claim 1 is are ineligible subject matter because the claimed limitations a computer-implemented gaming method include no recitation or insufficient recitation of a machine or transformation, or not directed to a proper application of a law of nature, or just a mere statement of a general concept. Although the claim discloses a gaming unit to receive and identifier, the claim fails to describe a gaming machine of performing the steps of identifying a player, determining the identifier, determining a time duration, initializing a timer, starting timer, determining a game outcome, determining an award, displaying any award, determining and displaying and determining a tournament score, and determining if the player is a winner.

Dependent Claim(s) 2-3, 6-7, 9-15, 17-20 when analyzed as a whole is/are held to be ineligible subject matter and are rejected under 35 U.S.C. 101 because the additional recited limitation(s) fail(s) to establish that the claim is not directed to an abstract idea as detailed below:

Additional limitations of how the identifier is stored, the specifics of how the tournament is played recited in dependent Claims 2-3, 6-7, 9-15, 17-20 are no more than a field of use or merely involve insignificant extra-solution activity or intangibly related to the performance of the steps.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 6-7, 9-15, 17-21, 24-25, 27-29, 61-62, 64-68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims incorporate the claim limitation of identifying a player of a first gaming unit, the player identified is association with a player tracking card, and receiving an identified associated with a tournament game card, the tournament game card is distinct from the player tracking card. Applicant's specification fails to explicitly disclose the steps of identifying a player of a first gaming unit, the player identified is association with a player tracking card, and receiving an identified associated with a tournament game card, the tournament game card is distinct from the player tracking card.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 6-7, 9, 13-15, 17-21, 24-25, 61, 67-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker'163 (US 6,077,163) in view of Shulman (US 2002/0123377).

Claims 1, 61. Walker'163 discloses a computer implement gaming method comprising and computer readable medium including computer executable program code for instructing a computer comprising (col. 3:63-4:5):

identifying a player of a first gaming unit, said player identified in association with a player tracking card (player game identification information stored on player tracking card, cols. 4:45-49, 6:1-12);

enabling the identified player to play game (102 in Figs 1-2B), the game associated with gaming software (The electronic gaming unit 102 loads and executes the gaming software to play the game, cols. 3:63-4:5);

receiving from said first gaming unit, and identifier associated with a game card an identifier (player game identification information stored on player tracking card, cols. 4:45-49, 6:1-12) the game card is provided to the player in response to paying fee (Player tracking game card is associated with player paid credit information, cols. 3:36-39, 6:5-6);

determining whether the identifier received from the first gaming unit is authentic (network server verifies the player identifying information, col. 3:54-56); and if the identifier is determined to be authentic

determining a time duration the identified player may play in the game based on the identifier, if the identifier is determined to be authentic (flat rate, time session is determined, cols. 3:6-17, 6:36-55);

initializing a timer with the amount of time (in other words, the length of time of the flat rate play session is established and the CPU can initiates a countdown, Walker'163, cols. 5:5-14, 12:30-51, 13:5-55);

starting the timer (Walker'163, cols. 12:30-51);

for each play of the game during the determined time duration:

determining a game outcome from a plurality of different game outcomes, determining any awards, and displaying the determined award (cols. 4:10-41);

stopping the timer after one of:

the timer has run for the determined amount of time duration (countdown reached zero, Walker'163, cols. 12:43-51), and

when the identified player terminates play on said first gaming unit prior to expiration of the amount of time of said determined time duration (player terminates play to play the remaining interval at a later time, Walker'163, cols. 13:5-55);

Walker'163 discloses a computer implement gaming method as discussed above but fails to teach that the tournament game card is distinct from the player tracking card, the game is a tournament, wherein the tournament is in progress when the identifier is received, and the player plays in the time remaining the tournament in progress a tournament score is displayed, a winner is determined based on a comparison of the tournament score with a tournament score of at least one different player and determining a value payout to be award to the identified winning player.

Regarding the claims limitation of the tournament game card is distinct from the player tracking card, it would have been obvious to one of ordinary skilled in the art to

modify Walker's tournament game card to be distinct from the player tracking card since it has been held that making components of an invention separable is obvious design change. *In re Dulberg*. This will provide a separate card to track the player and a separate card to store player's game credit. Therefore it would have obvious to one of ordinary skilled in the art to modify Walker'163 invention to have the tournament game card distinct form the player tracking card in order to provide a separate card to track the player and a separate card to store player's game credit.

Regarding the claim limitation of the game is a tournament, wherein the tournament is in progress when the identifier is received, and the player plays in the time remaining the tournament in progress a tournament score is displayed, a winner is determined based on a comparison of the tournament score with a tournament score of at least one different player and determining a value payout to be award to the identified winning player, in an analogous art to methods of play games, Shulman discloses a method of allowing a player to play in a tournament in progress, based on the time remaining in the tournament. More specifically, Shulman discloses a player can join the tournament after observing the tournament that's in progress (paragraphs 12, 16-18, and 31). The player can conveniently select the time periods during which the player will participate in the tournament (paragraph 12).The player can play in the tournament until the tournament ends ("until the remaining time in the tournament" since tournament ends at a specified time, paragraph 18). This allows the player to observe the game, including the type of players, their betting habits, and the aggressiveness of their play before joining the tournament (paragraph 16). According to Applicant's specification,

the claim limitation of "tournament score," may be the player's standing or player's total winnings (final score, paragraphs 93, 121, 139, 145). Similarly, Shulman discloses that the tournament score is displayed (number of chips remaining for each player, paragraph 15). The total winnings are compared against those of the other player to determine the tournament winner (abstract). Since the player total winning is the player balance, a value payout is awarded according to the tournament score/total winning. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Walker'163 method of playing a game, and incorporate Shulman's method of playing in a tournament in progress for the time remaining in the tournament, in order to allow a player to participate in a tournament after the player has observed the game.

Claim 2. The combination of Walker'163, and Shulman discloses the identifier is printed on the tournament game card (Walker'163, col. 4:42-53).

Claim 3. The combination of Walker'163, and Shulman discloses the identifier is electronically encoded on the tournament game card (Walker'163, col. 4:42-53).

Claims 6, 24. The combination of Walker'163 and Shulman discloses determining the duration based on the identifier comprises retrieving the duration from storage based on the identifier (Walker'163, col. 3:6-39; cols. 6:49-7:20).

Claims 7, 25. The combination of Walker'163, and Shulman discloses determining the time duration based on the identifier comprises decoding the identifier to determine the time duration (Walker'163, cols. 3:6-39, 4:42-65).

Claim 9. The combination of Walker'163, and Shulman discloses stopping the timer at a request of the player; and restarting the timer at a request of the player if the timer has not run for the determined amount of time (Walker'163, cols. 5:5-14, 12:43-51, 13:5-55).

Claim 13. The combination of Walker'163, and Shulman discloses a gaming method according to claim 8, wherein the timer is implemented, at least in part, by the first gaming unit (Walker'163, 12:43-51).

Claim 14. The combination of Walker'163, and Shulman discloses the first gaming unit is operatively coupled to the tournament game card, wherein the timer is implemented, at least in part, by the tournament game card (player tracking device is associated with player credits/flat rate remaining, Walker'163, cols. 5:5-14, 12:43-51, 13:5-55).

Claim 15. The combination of Walker'163, and Shulman discloses the timer is implemented, at least in part, by the tournament server (database server keeps track of player credits/and flat time remaining, Walker'163, cols. 5:5-14, 12:43-51, 13:5-55).

Claim 17. The combination of Walker'163, and Shulman discloses the gaming software comprises at least one of an executable file, a configuration file, a data file, a pay table, and a plurality of seeds for a random number generator (Walker'163 discloses gaming software stored in memory to execute slot game, col. 3:63-4:5. The program inherently comprises executable file, a configuration file, a paytable, and a plurality of seeds for a random number generator stored. Furthermore, Walker'163 discloses a RNG, col. 4:4-5, and a paytable 228 store in memory, col. 4:17, and Fig. 6.).

Claim 18. The combination of Walker'163, and Shulman discloses the tournament game card comprises at least one of a magnetic swipe card, a smart card, a PC card, and a portable memory device (Walker'163, col. 4:43-53).

Claim 19. The combination of Walker'163 and Shulman discloses receiving the tournament score of the player before the timer has stopped (Duration is based on score/winning outcomes. Thus the individual scores are tracked before the timer has stopped, Walker'163, col. 3:6-30. Furthermore the tournament score in Shulman is tracked after each round and thus can occur before a timer has stopped.).

Claim 20. The combination of Walker'163 and Shulman discloses receiving the tournament score of the player after the timer has stopped (Scores are received after the end of the game player to award the winning player).

Claim 21. See rejection for claim 1. More specifically, Walker'163 discloses the structural limitation of a server (106 in Figs.1 and 3) comprising:

a network interface (360 in Fig. 3),

a controller comprising a processor (310 in Fig. 3) and memory (320, 330 in Fig. 3) to store a game program and operate the game (col. 5:34-63). Shulman discloses a tournament server (processing station 20 in Fig. 1) for operating a tournament game.

Claim 67. See rejection for claims 1 and 21 above. More specifically, Walker'163 discloses the structural limitation of a computing system (100 in Fig. 1) including or more processors (within each gaming machine 21 in Fig. 2a, and within the server 310 in Fig. 3).

Claim 68. Walker'163 discloses the computing system includes a gaming machine (102 in Fig. 1) and a gaming server comprising the controller (106 in Fig. 3).

Claims 62 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker'163 in view of Shulman and further in view of Walker'173 (US 2002/0013173),

Claim 62. The combination of Walker'163 and Shulman discloses the method of playing for a duration of game play based on a tournament identifier and determining

the time duration that the player may play in the tournament in the time remaining the tournament as discussed above (see rejection for claim 1 above), but fails to teach that the first device is not configured for playing in the tournament when the first device is selected by the player for playing the tournament, configuring the first device to join the tournament. Nevertheless, it would have been obvious to one of ordinary skilled in the art to configure a gaming machine to play a particular game that is not originally configured. In an analogous art to playing games on a gaming machine, Walker'173 discloses a method of configuring a gaming machine (paragraphs 28, 69) upon an identifier (paragraphs 67-68). The identifier or identification number is associated with a player tracking card (paragraph 67). After the player identification number is then authenticated (paragraphs 35, 67), the gaming machine is configured according the player's information (paragraphs 28, 69-78). The player information may configure the gaming machine to play certain games (game eligibility, paragraphs 28, 48, 62). When modifying Walker'163 in view of Shulman's method of playing a tournament with Walker'173's method of configuring gaming machines that were not originally configured, gaming machines that are not configured to play in the tournament will now be configured to play in the tournament. Thus, the player can play on any gaming machine within the casino or gaming center. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify the method of playing a tournament game as suggested by the combination of Walker'163 and Shulman, and incorporate Walker'173's method of configuring a gaming machine,

in order to allow users play a tournament game using any gaming machine within the casino.

Claim 64. The combination of Walker'163, Shulman and Walker'173 discloses determining whether the tournament identifier has been received within an acceptable time window allocated for tournament play (The player can provide the identifier and enter the tournament when the tournament beings and until the tournament ends since Shulman discloses that a player can join the tournament after observing the tournament that's in progress. See Shulman paragraphs 12, 16-18, and 31).

Response to Arguments

Applicant's arguments with respect to claims 1-3, 6, 7, 13-15, 17-21, 24, 25, 61, 62, 64, 67, 68 have been considered but are moot in view of the new ground(s) of rejection. New grounds of rejection using the same art have been made to address the amended limitations.

It is noticed that the status identifier for claims 10-12, 27-29, 65-66 should be labeled as withdrawn.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 273-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melba Bumgarner/
Supervisory Patent Examiner, Art Unit 3717

JHY